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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,302	08/02/2005	Helmut Sippel	P04,0368	5971
26574	7590	10/31/2007		
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER PHAM, ANDY L	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/525,302

Applicant(s)

SIPPEL ET AL.

Examiner

Andy L. Pham

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/14/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 23 is objected to because of the following informalities: Claim 23 recites the limitation "the method" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. Furthermore, "a method for automatically eliminating an error during the operation of an electrographic printing or copying device" is not a step. It is suggested that it be deleted from the claim.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 provides for the use of a method, but, since the claim does not set forth any steps how the method is being used, it is unclear what process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. It is noted that the steps recited in the claim are directed to the method for automatically eliminating an error, and not the method for correcting errors as recited in the use of such method.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

The claim is drawn to a computer program per se. A computer program per se is abstract instructions. Therefore, a computer program is not a physical thing (product) nor a process as they are not "acts" being performed. As such, these claims are not directed to one of the statutory categories of invention (See MPEP 2106.01), but are directed to nonstatutory functional descriptive material.

It is noted that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se (signals or carrier waves).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimomura et al. USP 5,999,757.

Shimomura et al. teaches a method for automatically eliminating an error during operation of an electrographic printing or copying device (**Abstract**).

The method of eliminating an error upon which the applicant is claiming occurs ONLY “upon the occurrence of an error.” Assuming no error occurs, no steps of the method are taken to attempt to eliminate error during operation of the device.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Regarding claim 13, the method of eliminating an error upon which the applicant is claiming occurs ONLY "upon the occurrence of an error." Assuming now an error does occur, the steps of the method are then taken to attempt to eliminate error during operation of the device.

10. Claims 13-18 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimomura et al. USP 5,999,757 in view of Sadler USP 6,408,407.

Regarding claims 13, 21, 22, and 23, Shimomura et al. teaches an electrographic printing or copying device, comprising:

an input for printable media to be printed (units 8);

a print module including at least one printable media transport path, said printing modules printing on said printable media (units 8);

an output connected to said printing module to receive printed printable media (units 8);

a controller connected to said input and to said print module and to said output to detect an occurrence of an error and determine whether the error can be corrected automatically, said controller switching to error correcting mode in case the error can be corrected, otherwise ending the main error-correcting mode (sequence formulation section 23).

Shimomura et al. does not teach explicitly testing components in a direction opposite to a media flow path including, commanding a module to correct an error, transmitting a status signal indicating the error has been corrected if the correction is successful or if no error is present, otherwise transmitting a status signal indicating that

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the error is not corrected. However, it would be known to someone of ordinary skill in the art to test all components regardless of sequence or order (Col 5-6, lines 65-67 and 1-9).

Shimomura et al. does not teach in case the status signal that the error has not been corrected is transmitted, determining whether operation of the printing or copying device can proceed without the module having the error, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected; and

after all affected modules have been queried, ending error-correcting mode if an occurrence of a status signal indicating that an error is not corrected and at least one module persists and reporting an error in the error module, otherwise ending the error-correcting mode and transmitting a status signing indicating error corrected.

Sadler teaches in case the status signal that the error has not been corrected is transmitted, determining whether operation of the printing or copying device can proceed without the module having the error, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected (Col 4 and 5; lines 66-67 and 1-6); and

after all affected modules have been queried, ending error-correcting mode if an occurrence of a status signal indicating that an error is not corrected and at least one module persists and reporting an error in the error module, otherwise ending the error-correcting mode and transmitting a status signing indicating error corrected (**Abstract**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the error delegating processing system as taught by Sadler in the sheet transportation device of Shimomura et al. for the purpose of transmitting status signals indicating errors.

Regarding claim 14, Sadler teaches in case a module indicates a status signal showing that an error has not been corrected, determining whether the module can be bypassed; and

If the module can be bypassed, then transmitting a status signal indicating operation possible, otherwise transmitting a status signal indicating error not corrected (Col 4 and 5; lines 66-67 and 1-6).

Regarding claim 15, Shimomura et al. teaches controlling error correction by a dedicated control unit (sequence formulation section **23**) of a querying component that is controlled by a main control unit (evaluation section **22**) of the printing or copying device.

Regarding claim 16, Shimomura et al. teaches separately testing the plurality of consecutively arranged components of the printing or copying device (Col 4, lines 26-35).

Regarding claim 17, Shimomura et al. does not teach explicitly testing components in a direction opposite to a media flow path. However, it would be known to someone of ordinary skill in the art to test all components regardless of sequence or order (Col 5-6, lines 65-67 and 1-9).



Regarding claim 18, Shimomura et al. teaches wherein said components of the printing or copying device include input components and output components for printable media (Col 4, lines 21-25).

Regarding claim 20, Shimomura et al. teaches wherein said modules are transport modules for transporting printable media (Col 4, lines 21-25) and a correction is undertaken to correct a paper jam of at least one sheet of the printable media (Col 5, lines 61-67).

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimomura et al. USP 5,999,757 in view of Sadler USP 6,408,407 as applied to claims 13 and 18 above, and further in view of Boehmer et al. USP 6,317,581.

The combined teachings of Shimomura et al. and Sadler teach the limitations of claim 18 as applied for reasons above.

Shimomura et al. and Sadler do not teach wherein print components are disposed in multiple groups between said input components and said output components and further comprising at least one switch module so that a plurality of transport paths are defined for printable media.

Boehmer et al. teaches wherein print components are disposed in multiple groups between said input components and said output components and further comprising at least one switch module (second shunt **W2** and third shunt **W3**) so that a plurality of transport paths are defined for printable media (adjoining transport paths **44**, **48**, **52**; Col 4, lines 19-22)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a plurality of transport paths for printable media as taught by Boehmer et al. for the use in the sheet transporting device of Shimomura et al. and Sadler to redirect printable media to another transport path during a paper jam.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy L. Pham whose telephone number is 571-270-1877. The examiner can normally be reached on Monday-Friday 7:30-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**JUDY NGUYEN**  
**SENIOR PATENT EXAMINER**